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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/883,229

### Applicant(s)

KANJI ET AL.

### Examiner

JYOTHSNA A VENKAT Ph. D

### Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-118 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-66, 70-101, 104-118 is/are rejected.
- 7) ☒ Claim(s) 67-69, 102 and 103 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Receipt is acknowledged of response filed on 8/28/04. Claims 1-118 are –pending in the application and the status of the application is as follows:

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-12, 14, 16, 32-34, 38-45, 47, 49-60, 62, 64-65, 69-80, 82, 84-94, 96, 98-100, 103, 104-114, 116 and 118 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 5,085, 859('859).

#### **Claim construction:**

Claims 1-16 are drawn to compositions; claims 32-50 are also drawn to compositions except the Polymethylsilsesquioxane polymer used in the compositions of claims 1-16 has the property” long wear or transfer resistance”; claims 51-70 are also drawn to compositions except the composition is a mascara composition ; claims 71-85 are also drawn to compositions with additional ingredient being UV absorber; claims 86-103 are drawn to compositions except the composition is an eyeliner composition; and claims 104-118 are compositions except the compositions are in the form of make-up for lips. The examiners’ position is that all the claims are drawn to compositions and the intended use and the property does not carry any patentable weight.

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See col.4, lines 8-60 for the Polymethylsilsesquioxane polymer claimed broadly with the repeating unit .see col.9, lines 4-20 for the various film formers which reads on the ingredient (b) and also on the claims wherein the film former is di-block, triblock or multiblock copolymer film formers. See col.10, lines 15-18 for the ranges of the ingredients a and b. There is overlap of the ingredients. See col.12, line 44 for UV absorber, and also other additives. See the last paragraph for thickener. The polymer claimed under (a) is same therefore the average molecular weight, the property claimed, melting point, and the limitation claimed in claims 8, 23, 56, 76, 90, and 109 are inherent. Note that the patent discloses cage like structure at col.4.

***Response to Arguments***

3. Applicant's arguments filed 8/28/04 have been fully considered but they are not persuasive.
4. Applicants argue that the patent '859 discloses only one ingredient which is “ an interpenetrating polymer network which includes a non-polar silsesquioxanes and a substituted vinyl copolymer and applicants point out that interpenetrating polymer network is an intimate combination of two polymers with each polymer being in net work form and this is not a blend of two preformed polymers where as the instant claims are drawn to two film formers and these polymers do not form a interpenetrating polymer network.
5. In response to the above rejection, it is the position of the examiner, that the claims are drawn to composition comprising two components and the patent disclosing two components in the network anticipates the claims.

6. Claims 17-27, 29, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 5,085, 859 ('859) as evidenced by Harry's Cosmeticology by Ralph Harry pages 50, and 754.

7. The Harry's cosmeticology is relied for the accepted meaning that ' lotions' are emulsions and emulsions can be either oil-in water or water in oil as disclosed at page 754.

8. See col.12, line 46 for " lotion" see the paragraph bridging col.s 13-14 for emulsions which reads on the claimed " emulsions" .See col.4, lines 8-60 for the Polymethylsilsesquioxane polymer claimed broadly with the repeating unit .see col.9, lines 4-20 for the various film formers which reads on the ingredient (b) and also on the claims wherein the film former is di-block, triblock or multiblock copolymer film formers. See col.10, lines 15-18 for the ranges of the ingredients a and b. There is overlap of the ingredients. See col.12, for other additives. See the last paragraph for thickener. The polymer claimed under (a) is same therefore the average molecular weight, the property claimed, melting point, and the limitation claimed in claims 8, 23, 56, 76, 90, and 109 are inherent. Note that the patent discloses cage like structure at col.4.

### ***Response to Arguments***

9. Applicant's arguments filed 8/28/04 have been fully considered but they are not persuasive.

10. Applicants argue that a claim is only anticipated if each and every element of the claim is taught by prior art reference and the patent fails to anticipate claims 32-50 drawn to cosmetic foundation composition, claims 51-70 drawn to mascara composition, claims 51-70 drawn to eyeliner composition, and 104-11 drawn to make-up composition since the patent is drawn to hair fixative composition.

11. In response to the above argument, it is still the position of the examiner that the claims are drawn to compositions and the intended use does not carry any patentable weight.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 1-66, 70-101, and 104-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents' 659 and 5,756,082('082) and 5,959,009('009).

The instant application is claiming compositions comprising:

1) *Polymethylsilsesquioxane*

2) *Film former, which is different than the component one. The species are various styrene block copolymers*

*3) Various additives (claim 36 is to thickening agent and claim 37 is to emollient)*

The claims are drawn to compositions or emulsions and these compositions are useful in lipsticks, mascara and eyeliners.

The patent teaches ingredient 1 as a film-forming component. See the abstract and see col.4, lines 8-60 for the Polymethylsilsesquioxane polymer claimed broadly with the repeating unit .see col.9, lines 4-20 for the various film formers which reads on the ingredient (b) and also on the claims wherein the film former is di-block, triblock or multiblock copolymer film formers. See col.10, lines 15-18 for the ranges of the ingredients 1 and 2. There is overlap of the ingredients. See col.12, line 44 for UV absorber, and also other additives. See the last paragraph for thickener. The difference between the patent and the claims is the patent does not disclose the limitation of claims 36 and 37 with respect to the ranges and also to the limitation where in the percent of ingredient 1 is higher than film former 2 and the specific film formers claimed in claims 13, 28, 4863, 83, 97 and 115.

The patents '009 and '082 teach components 2-3 in cosmetic compositions. See col.2, lines 1-15 for the film former and see col.2, lines 49-54 for non-volatile oil which are used as emollients, see col.3, lines 15-25 for the ingredients alginates, carbomers, celluloses, gums, silicates, carrageenans which are thickening agents and also known as gellants. See the example 1 where the patent teaches the use of two film formers in the compositions claimed in claims 66, and 101. See col.2, lines 30-50('082) for the specific film formers claimed in claims 13, 28, 4863, 83, 97 and 115 se the examples for " cyclomethicone" which are used as emollients. The film formers are used in cosmetic compositions to form a film so that it repels water as water and polymers are not miscible.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '859 and combine it with the film formers of '009 or '082 and expecting beneficial effect to the cosmetic compositions. The motivation to use the *film formers of '082* in the compositions stems from the teachings of the patent that this polymer along with oils and polymers provide the compositions having less residue when applied and excellent esthetics and the film formers of '009 when added to the compositions of '859 along with oil( emollients), gellant( thickening agent) provide the compositions water proof or water resistant compositions. One of ordinary skill in the art would expect reasonable amount of success that by using the combination of Polymethylsilsesquioxane polymer, film former and emollient and thickening agents, the compositions exhibit excellent esthetics and waterproof properties. This is prima facie case of obviousness.

#### ***Response to Arguments***

15. Applicant's arguments filed 8/28/04 have been fully considered but they are not persuasive.

Applicants argue that the patent '082 does not teach higher amount of silsesquioxanes and neither the patent '082 nor patent '099.

In response to the above argument, it is the position of the examiner that the patent at col.10, lines 15-20 teaches the range for the silsesquioxanes and film-forming agent to be the same , however increasing the amount of silsesquioxanes compared with the film-forming agent is within the ken of the skilled chemist.



Applicants point out that patent '859 is directed towards hair fixative compositions and one of ordinary skill in the art would not be motivated to look to film forming agents used in water proof mascara or deodorant compositions.

In response to the above argument, it is the position of the examiner that the claims are drawn to compositions and the intended use claimed or taught by the patent does not carry any patentable weight. The patent '859 at col.9 teaches various film forming agents and patent '009 at col.2, lines 35-36 teaches that the film-forming agent improves the wear of the composition and the patent '082 teaches the block polymers claimed in the cosmetic compositions and therefore one of ordinary skill in the art would certainly be motivated to use various film formers in the cosmetic compositions with the reasonable expectation of success that the se film-formers would improve the wear of the compositions. Absent a showing the criticality of the various film- formers claimed giving unexpected and superior results commensurate with the scope of claims, the claims are rendered prima facie obvious within the meaning of 35 U. S. C. 103 over the combination of the patents.

***Allowable Subject Matter***

16. Claims 67-69, and 102-103 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**JYOTHSNA A VENKAT Ph. D**  
Primary Examiner  
Art Unit 1615

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